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09/346,134

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MICHAEL D. ELLIS

UV-85

2049

7590

05/24/2004

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EXAMINER

BELIVEAU, SCOTT E

ART UNIT

PAPER NUMBER

2614

7

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/346,134

Applicant(s)

ELLIS ET AL.

Examiner

Scott Beliveau

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-51, 103-106, 111-114 and 121-126 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-51, 103-106, 111-114 and 121-126 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1,2,6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 52-102, 107-110, and 115-120 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.

### *Priority*

2. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged.  
However, the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 11, 28, 45, 15, 32, 49, 16, 33, 50, and 103-126 of this application. In particular, the provisional application makes no reference to the usage of a chat room in conjunction with the disclosed embodiment, the particular implementation architecture utilized by the embodiment such that the some applications may be implemented via servers over the Internet or via a television distribution facility, or the implementation of the various applications through multiple interconnected user television equipment devices.

### *Drawings*

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 170 (Figure 11); 134, 136, 271 (Figure 9); 366 (Figure 32). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Specification*

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
5. Updated status of all co-pending applications is further required as appropriate.
6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification discloses that the program guide application may be either implemented partially on the user television equipment or may be implemented on user television equipment (IA: Page 19, Lines 25-28). The specification only does not particularly utilize the term "only" in conjunction with the non-partial implementation embodiment. Accordingly, the examiner suggests that the specification be amended in order to utilize consistent language with the claims as originally filled wherein an amendment to the specification be made such that the aforementioned referenced section read "... such as server 59 or may be only be implemented on user television equipment 40.

*Claim Objections*

7. Claims 103-106 are objected to because the references to "coordinat[ing] access to the resources" lacks proper antecedent basis. For the purpose of art evaluation, the examiner shall presume the phrase has been amended to read, "coordinate access to [the] resources". Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

9. Claims 103, 104, 111, and 112 are rejected under 35 U.S.C. 102(a) as being anticipated by Ellis et al. (WO 99/13641).

In consideration of claims 103 and 111, Figure 1 of the Ellis et al. reference discloses a system and method comprising a “television distribution facility” [16] comprising a “server” on which at “least one non-program guide-application is implemented” (Page 6, Line 27 – Page 7, Line 27) and “user television equipment” [22] comprising software based “means” that is “connected to” [20] the “television distribution facility for receiving television programming” (Page 8, Line 30 – Page 9, Line 8). As illustrated in Figure 3, the embodiment comprises an “application program interface” [54] and an “interactive television program guide wherein the “application program interface” [54] is operable to “coordinate access to the resources” [68] “among the interactive television program guide application and the at least one non-program-guide application” (Page 18, Line 3 – Page 19, Line 16).

Claims 104 and 112 are rejected wherein there are a “plurality of non-program-guide applications implemented on the server” including home shopping, audio-on-demand applications, banking applications, wagering applications, etc. (Page 7, Lines 6-27) and the system [10] further comprises “means for using the application program interface to

coordinate access to the resources among the interactive television program guide application and the plurality of non-program guide applications” (Page 18, Lines 3-8).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
12. Claims 1-51, 105, 106, 113, 114, and 121-123 are rejected under 35 U.S.C. 103(a) as being obvious over Ellis et al. (US Pat No. 6,665,869) in view of Schein et al. (US Pat No. 6,388,714) with associated Appendix B “Starsight Interactive Television Program Guide, Phase III).

The applied reference (Ellis et al.) has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a

showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c).

In consideration of claims 1, 18, and 35, the Ellis et al. reference discloses an “interactive television program guide” [10] and “method” wherein an “interactive television program guide application” [56] is “at least particularly implemented on user television equipment of a user” [22]. The reference discloses “user television equipment” [22] or “means” for implementing the disclosed software architecture. Accordingly, the “user television equipment” [22] “at least partially implements” both a “program-guide application” [56] and “non-program guide application that provides an interactive component” [58/60/62/64] including Internet browser applications, a video-on-demand application, a shopping application, an electronic mail application, etc. (Col 2, Lines 9-15). The “program-guide application” further comprises an “application program interface” [54] that “allows the non-program-guide application to use program guide functions of the interactive television program guide application when providing the interactive component to the user” and is further “called” by the “non-program-guide application . . . to provide the interactive

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component using a program guide function (Col 6, Lines 4-15; Col 7, Line 63 – Col 8, Line 13).

The reference, however, does not explicitly disclose nor preclude the “means for launching the non-program-guide application with the interactive television program guide application”. In particular, the reference is silent as to the nature of the program guide with which the teachings are applicable. The Schein et al. reference discloses a method wherein a user from within a “program-guide application” is operable to launch or serve as a portal to “non-program guide applications” including video-on demand, home shopping, etc. (Figure 15A). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to an electronic program guide such as Schein et al. that enables a user to access multiple applications via an electronic program guide for the purpose of providing the user with a friendly and easy means for accessing non-program applications via a program-guide application interface. The particular usage of the Schein et al. embodiment furthermore advantageously provides an efficient method to facilitate an exchange of information between television viewers and producers, promoters and advertisers during the broadcast of the commercial or program such that the viewer may utilize the program-guide application to easily access a non-program guide application associated with home shopping (Schein et al.: Col 1, Line 65 – Col 2, Line 17; Col 17, Lines 8-27).

Claims 2, 5, 19, 22, 36, and 39 are rejected wherein the “means for launching comprises means for displaying an on-screen option on the user television equipment with the interactive program guide application” wherein the “on-screen option . . . displays a menu



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option on a program guide display screen” [712] (Schein et al.: Figure 15A; Appendix B, Section B3 – Going Other Places)

In consideration of claims 3, 4, 20, 21, 37, and 38, as disclosed in Schein et al. Appendix B (Section D1 – Channel Guide/VOD), the embodiment further comprises “means for including video-on-demand program listings as part of a program guide display screen displayed on the user television equipment by the interactive television program guide applications” wherein the “video-on-demand program listings [are] in a list of program listings displayed on the user television equipment by the interactive television program guide application”.

Claims 6, 23, and 40 are rejected wherein the aforementioned “on-screen option” [712], as disclosed in Schein et al. Appendix B (Section B3 – Going Other Places), is “displayed . . . in a program guide display screen containing program listings devoted to a specific type of content with the interactive television guide application”. For example, the “on-screen option” is displayed in conjunction with program listings devoted to a specific type of content such as Favorite programs.

Claims 7, 24, and 41 are rejected wherein the “means for launching further comprises means for launching the non-program guide applications with the interactive television guide application using a hot link” such that the user may invoke non-program guide applications related to a current television program (Schein et al.: Col 14, Lines 1-17; Appendix B, Section C6.1-2 – Linked Services)

Claims 8, 25, and 42 are rejected wherein the “hot link” relates to a “web browser application” wherein the embodiment is operable to “launch the web browser application

from the interactive television program guide application” and “direct the web browser application to access a web page with content related to the content of the interactive program guide application” (Schein et al.: Col 16, Line 64 – Col 16, Line 8; Col 19, Line 51 – Col 20, Line 16; Appendix B, Section C6.1 – Linked Services)

In consideration of claims 9, 26, and 43, the Schein et al. reference discloses that the embodiment is operable to “launch the electronic mail application from the interactive television program guide application”. The reference further suggests that the user is interact with other users, program sponsors, advertisers, etc. (Col 15, Lines 64-67) including the ability to request information related to an advertised product (Col 16, Lines 56-67). The examiner takes OFFICIAL NOTICE that it is notoriously well known in the art for a user to request additional information or interact with program sponsors, advertisers, etc. via email. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a means for “directing the electronic mail application to address electronic mail to an address related to the content of the interactive television program guide application” in conjunction with the ability to interact or request additional information from product advertisers for the purpose of providing the user with an easy and efficient means to interact or request additional information without needing to write down the corresponding email address.

Claims 10, 27, and 44 are rejected wherein the “hot link” relates to a “web home shopping application” wherein the embodiment is operable to “launch the home shopping application from the interactive television program guide application” and “direct the home shopping application to present products related to the content of the interactive program

guide application” (Schein et al.: Col 20, Lines 16-44; Appendix B, Section C6.1 – Linked Services).

Claims 11, 28, and 45 are rejected wherein the “hot link” relates to a “chat application” wherein the embodiment is operable to “launch the chat shopping application from the interactive television program guide application” and “direct the chat application to perform functions based on the content of the interactive program guide application” (Schein et al.: Col 15, Line 64 – Col 16, Line 8)

In consideration of claims 12, 29, and 46, the Ellis et al. reference discloses that the “application program interface” [54] further enables the non-program guide applications” [58/60/62/64] to utilize the same graphics library resources [68B] associated with the “interactive television program-guide application” [56] (Col 6, Lines 39-64). The Schein et al. reference illustrates the particular usage of a “consistent user interface” in conjunction with the various applications. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made that in conjunction with sharing graphic library resources associated with the generation of on-screen menus to “maintain a consistent user interface” for the purpose of providing an efficient way for generating user screens in a manner that does not require the additional overhead associated with each application and further minimizes confusion and annoyances to the user associated with the dissimilarity in appearance and behavior between applications.

Claims 13, 30, and 47 are rejected wherein the Ellis et al. reference discloses that there are a “plurality of non-program-guide applications” [58/60/62/64] including Internet browser applications, a video-on-demand application, a shopping application, an electronic mail

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application, etc. (Col 2, Lines 9-15). The “application program interface” [54] further comprises “means for coordinating access to platform resources” [66] among the “interactive program guide application” [56] and the “non-program guide applications” [58/60/62/64] (Col 2, Lines 29-38, 47-55; Col 8, Lines 14-54).

Claims 14, 31, and 48 are rejected wherein the Ellis et al. reference discloses that the “interactive television program guide application” [56] comprises a “number of program guide resources” [68] wherein the “application program interface” [54] comprises “means for providing the non-program-guide applications with access to the program guide resources” (Col 2, Lines 16-28; Col 7, Line 63 – Col 8, Line 13)

Claims 15, 16, 32, 33, 49, and 50 are rejected wherein the “interactive television program guide application” may be either “partially implemented on a server” or “only on the user television equipment” (Schein et al.: Col 3, Lines 63 – Col 4, Line 9; Col 16, Lines 8-24)

Claims 17, 34, and 51 are rejected wherein as disclosed in Schein et al. Appendix B (Section D1 – Channel Guide/VOD), the embodiment further comprises “means for embedding non-program guide application content in a program guide display screen provided by the interactive television program guide application” such that video-on-demand programs may be displayed in conjunction with other program content associated with the channel guide screen.

In consideration of claims 105, 106, 113 and 114, the Ellis et al. reference discloses that banking applications, wagering applications, and data service applications may be provided using facilities separate from the television distribution facility, however, it does not explicitly disclose that such applications are necessarily provided via a “server on the

Internet". The Schein et al. reference discloses that it is known in the art to provide such services via "servers over the Internet" (Figure 10). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such applications including banking applications, wagering applications, and data service applications using a separate facility or "servers over the Internet" for the purpose of providing flexibility which such applications may be delivered and for reducing the television facility storage requirements associated with advantageously providing the user with a large number of applications.

In consideration of claims 121-123, Figure 1 of the Ellis et al. reference discloses a system and method comprising a "television distribution facility" [16] that "provides television programming" (Col 4, Lines 20-24) which is "received" via "user television equipment" [22] comprising "resources" [66]. The "user television equipment" implements both an "application program interface" [54] and an "interactive television program guide application at least partially on the user television equipment wherein the "application program interface" [54] is operable to "coordinate access to the resources" [68] "among the interactive television program guide application and the at least one non-program-guide application" (Col 2, Lines 47-55).

While the Ellis et al. reference discloses that "non-program-guide applications" such as banking applications, wagering applications, and data service applications may be provided using facilities separate from the television distribution facility, the reference does not explicitly disclose that such applications are necessarily provided via a "server on the Internet". The Schein et al. reference discloses that it is known in the art to provide such

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services via “servers over the Internet” (Figure 10). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide such applications including banking applications, wagering applications, and data service applications using a separate facility or “servers over the Internet” for the purpose of providing flexibility which such applications may be delivered and for reducing the television facility storage requirements associated with advantageously providing the user with a large number of applications.

13. Claims 124 and 125 are rejected under 35 U.S.C. 103(a) as being obvious over Ellis et al. (US Pat No. 6,665,869) in view of Bellamy (US Pat No. 6,209,025).

In consideration of claims 124 and 125, the Ellis et al. reference discloses a system [22] comprising “multiple user interconnected user television equipment devices in the home of a user” including a set-top box that may be coupled to a computer (Col 5, Lines 13-16). Accordingly, the reference discloses means for “implementing an interactive program guide application” on a “first user television equipment device” [24] that is “connected” [42] to a “second user television equipment” wherein a “program guide application program interface” [54] is “implemented on at least one of the first and second user television equipment devices” and “coordinates access of the interactive television program guide application and the other application to the resources” (Col 2, Lines 47-55).

The reference, however, does not explicitly disclose nor preclude that “other applications” or non-program-guide applications including an email application may not be implemented on the “second user television equipment device” through other physical devices such as the attached computer. However, the particular usage of interconnected user

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television equipment implementing variously applications is known in the art. For example, the Bellamy reference discloses an integrated video system wherein a computer [10] executes an email application and upon the receipt of a new email message it utilizes the set-top box [5] to generate an alert to the user (Col 7, Lines 27-35). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to execute "at least one other application on a second user television equipment device that is connected to the first user television equipment device" as illustrated in Bellamy for the purpose of providing a means by which a computer may inform the user of the occurrence of telephony/Internet related events while the user is watching television (Bellamy: Col 1, Lines 46-50) in a manner that efficiently coordinates requests for set-top box resources as taught by Ellis. For example, taken in combination, the email application executing on the PC may demand the usage of particular commonly utilized graphic library resources executing on the user television equipment [22]. The Ellis et al. reference discloses a method for advantageously coordinating requests for a particular resource through the program guide application interface.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Stautner et al. (US Pat No. 6,172,677) reference discloses an integrated content guide for multiple sources with hypertext links to related content information.
- The Killian (US Pat No. 6,163,316) reference discloses a JAVA® based television operating system and EPG that utilizes an application program interface to facilitate application operations.
- The Thrift (US Pat No. 6,510,557) reference discloses a JAVA® television receiver that utilizes an application program interface in order to facilitate the integrated display of television and internet content.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907.

The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).




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SEB

May 5, 2004

  
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